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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PHAM, THIERRY L	
ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,341

Applicant(s)

BURQUIST ET AL.

Examiner

Thierry L. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 7/11/06.
- Claims 1-35 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moscato et al (US 6335978), and in view of Kitabatake (US 6099181).

Regarding claim 35, Moscato discloses a system (system 10 for verifying document, fig. 1) for verifying a document comprising:

- (RIP 11 for providing image data 13, fig. 1) providing a first electronic image (original image 13, fig. 1) of a document;
- (imaging device 15, fig. 1) providing a second electronic image (scanned copy of printed image 16, fig. 1) of a document, said second electronic image being a scanned copy (scanned copy image 21 is a printed version of image data 13, fig. 2) of a printed version of said first electronic image; and
- (comparison device 12 for comparing original image 13 and printed image 21, fig. 1, col. 3, lines 35-65) comparing said first and second electronic images and providing an output (output response 22 as shown in fig. 1, col. 3, lines 35-65) response thereto, wherein said output signifies whether said printed version of said first electronic image is a successful print (verifying/analyzing any discrepancy to determine whether printed version of original image is successful print, col. 2, lines 4-15).

However, Moscato fails to teach and/or suggest a prohibition of printing another copy if a printed page has been successfully printed.

Kitabatake, in the same field of endeavor for printing, teaches a prohibition of

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printing another copy if a first printed copy is successfully printed (reprinting is prohibited if the printed page has been successfully printed, col. 2, lines 8-11, col. 11, lines 18-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify printing system of Moscato to prohibit printing of another copy of successful printed page as taught by Kitabatake because of a following reason: (1) to eliminate consumable wastes such as ink and paper via prohibiting reprinting an additional copy if a first copy has been successfully printed.

Therefore, it would have been obvious to combine Moscato with Kitabatake to obtain the invention as specified in claim 35.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moscato et al (US 6335978), and in view of Manchala et al (US 6088119).

Regarding claim 35, Moscato discloses a system (system 10 for verifying document, fig. 1) for verifying a document comprising:

- (RIP 11 for providing image data 13, fig. 1) providing a first electronic image (original image 13, fig. 1) of a document;
- (imaging device 15, fig. 1) providing a second electronic image (scanned copy of printed image 16, fig. 1) of a document, said second electronic image being a scanned copy (scanned copy image 21 is a printed version of image data 13, fig. 2) of a printed version of said first electronic image; and
- (comparison device 12 for comparing original image 13 and printed image 21, fig. 1, col. 3, lines 35-65) comparing said first and second electronic images and providing an output (output response 22 as shown in fig. 1, col. 3, lines 35-65) response thereto, wherein said output signifies whether said printed version of said first electronic image is a successful print (verifying/analyzing any discrepancy to determine whether printed version of original image is successful print, col. 2, lines 4-15).

Moscato fails to teach and/or suggest teaches a prohibition of additional printed version from being produced if said output is signified to be a successful print.

Manchala, in the same field of endeavor for printing, teaches a prohibition of additional printed version from being produced if said output is signified to be a

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successful print (reprinting is prohibited if the first printed check is successful printed, col. 2, lines 30 to col. 3, lines 35 and col. 5, lines 1-10).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify printing system of Moscato to include a prohibition unit/flag to prevent printing of additional copy of successful printed image as taught by Manchala because of a following reason: (●) to prevent unauthorized reprinting of additional checks (col. 3, lines 15-18 and lines 62-63); (●) to prohibit reprinting of an additional documents (e.g. movie tickets, checks, stamps, and etc) that users/operators are not entitled to.

Therefore, it would have been obvious to combine Moscato with Manchala to obtain the invention as specified in claim 35.

Claims 1-5, 10-21, 26-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moscato et al (US 6335978), and in view of Pierce et al (US 6680783).

Regarding claim 1, Moscato discloses a system (system 10 for verifying document, fig. 1) for verifying a document comprising:

- first means (RIP 11 for providing image data 13, fig. 1) for providing a first electronic image (original image 13, fig. 1) of a document;
- second means (imaging device 15, fig. 1) for providing a second electronic image (scanned copy of printed image 16, fig. 1) of a document, said second electronic image being a scanned copy (scanned copy image 21 is a printed version of image data 13, fig. 2) of a printed version of said first electronic image; and
- third means (comparison device 12 for comparing original image 13 and printed image 21, fig. 1, col. 3, lines 35-65) for comparing said first and second electronic images and providing an output (output response 22 as shown in fig. 1, col. 3, lines 35-65) response thereto, wherein said output signifies whether said printed version of said first electronic image is a successful print (verifying/analyzing any discrepancy to determine whether printed version of original image is successful print, col. 2, lines 4-15).

However, Moscato fails to teach and/or suggest prohibiting of additional printed version from being produced from another print request if output is signified to be

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successful print.

Pierce, in the same field of endeavor for printing, teaches well-known example of prohibiting of additional printed version (prohibiting and/or preventing additional and/or multiple copies of document from printing, col. 3, lines 5-25 and col. 6, lines 42-62) from being produced from another print request (col. 6, lines 42-62) if output is signified to be successful print.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify printing system of Moscato to include a means for prohibiting of additional printed version from being produced from another print request if output is signified to be successful print as taught by Pierce because of a following reason: (1) to prevent unauthorized duplication and/or multiple copies of postage indicium (ref. 320 of fig. 3) from printing (col. 3, lines 8-15 of Pierce).

Therefore, it would have been obvious to combine Moscato with Pierce to obtain the invention as specified in claim 1.

Regarding claim 2, Moscato further discloses the invention of claim 1 wherein said second image is derived from said first image (image 21 is derived from original image 13 via printer 15, fig. 1, col. 3, lines 35-65).

Regarding claim 3, Moscato further discloses the invention of claim 1 wherein said second means includes a scanner (scanner 20, fig. 1, and scanner 20 can also be incorporated within printer 15, fig. 3).

Regarding claim 4, Moscato further discloses the invention of claim 3 wherein said second means includes a printer (printer 15, figs. 1 and 3).

Regarding claim 5, Moscato further discloses the invention of claim 4 wherein said scanner (scanner 20, fig. 1, and scanner 20 can also be incorporated within printer 15, fig. 3) is mounted to scan a document printed by said printer to provide said second image.

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Regarding claim 10, Pierce further teaches the invention 5 further including means for detecting a print restriction (only one copy is allowed, col. 3, lines 5-25) with respect to said first image.

Regarding claim 11, Pierce further teaches the invention of claim 10 further including means responsive to said print restriction and said third means for disabling (col. 4, lines 60-63 and col. 6, lines 42-60) a second print of said document.

Regarding claim 12, Moscato further teaches the invention of claim 1 wherein said first means includes a personal computer (RIP 11 or XL Data system 26, fig. 1-2 respectively).

Regarding claim 13, Moscato further teaches the invention of claim 12 wherein said first image is obtained from a network (fig. 1).

Regarding claim 14, Moscato further teaches the invention of claim 13 wherein said network is the Internet (providing images via Internet is well known

Regarding claims 15-17, Moscato further teaches the invention of claim 1 wherein said third means include software stored on a computer readable medium (comparison device 12, fig. 1, and obviously, comparison device 12 includes a computer instruction program for comparing original image with printed image, for example, OCR software).

Regarding claims 18-19, Moscato further teaches the invention of claim 1 wherein said third means includes means for converting said first image to text (comparison device 12, fig. 1, and obviously, comparison device 12 includes a computer instruction program for comparing original image with printed image, for example, OCR software).

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Regarding claim 20, Moscato further teaches the invention of claim 19 wherein said third means includes means for comparing the text representing said first image to said text representing said second image (OCR software for comparing texts are well known and widely available).

Regarding claim 21, Moscato further discloses a system (system 10 for verifying document, fig. 1) for verifying a printed document comprising:

- a computer (RIP 11 for providing image data, fig. 1) for providing a first electronic image (original image 13, fig. 1) of a document;
- a printer (imaging device 15, fig. 1) coupled to said computer;
- a scanner (scanner 20, fig. 1) adapted to scan a document printed by said printer to provide a second electronic image (printed image 21, fig. 1) of said document, said second electronic image being a scanned copy of a printed version of said first electronic image; and
- software (comparison device 12, fig. 1, and obviously, comparison device 12 includes a computer instruction program for comparing original image with printed image, for example, OCR software) for comparing said first and second electronic images (comparison device 12 for comparing original image 13 and printed image 21, fig. 1, col. 3, lines 35-65) and providing an output response thereto (output response 22 as shown in fig. 1, col. 3, lines 35-65), wherein said output signifies whether said printed version of said first electronic image is a successful print (verifying/analyzing any discrepancy to determine whether printed version of original image is successful print, col. 2, lines 4-15).

However, Moscato fails to teach and/or suggest prohibiting of additional printed version from being produced from another print request if output is signified to be successful print.

Pierce, in the same field of endeavor for printing, teaches well-known example of prohibiting of additional printed version (prohibiting and/or preventing additional and/or multiple copies of document from printing, col. 3, lines 5-25 and col. 6, lines 42-62) from being produced from another print request (col. 6, lines 42-62) if output is signified to be

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successful print.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify printing system of Moscato to include a means for prohibiting of additional printed version from being produced from another print request if output is signified to be successful print as taught by Pierce because of a following reason: (1) to prevent unauthorized duplication and/or multiple copies of postage indicium (ref. 320 of fig. 3) from printing (col. 3, lines 8-15 of Pierce).

Therefore, it would have been obvious to combine Moscato with Pierce to obtain the invention as specified in claim 21.

Regarding claim 26, Pierce further teaches the invention 21 further including means for detecting a print restriction (only one copy is allowed, col. 3, lines 5-25) with respect to said first image.

Regarding claim 27, Pierce further teaches the invention of claim 26 further including means responsive to said print restriction and said third means for disabling a second print of (col. 4, lines 60-63 and col. 6, lines 42-60) said document.

Regarding claim 28, Moscato further teaches the invention of claim 21 wherein said first image is obtained from a network (fig. 1).

Regarding claim 29, Moscato further teaches the invention of claim 28 wherein said network is the Internet (providing images via Internet is well known).

Regarding claims 30-31, Moscato further teaches the invention of claim 30 wherein said third means include software stored on a computer readable medium (comparison device 12, fig. 1, and obviously, comparison device 12 includes a computer instruction program for comparing original image with printed image, for example, OCR software).

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Regarding claims 32-33, Moscato further teaches the invention of claim 30 wherein said third means includes means for converting said first image to text (comparison device 12, fig. 1, and obviously, comparison device 12 includes a computer instruction program for comparing original image with printed image, for example, OCR software).

Regarding claim 34, Moscato further teaches the invention of claim 33 wherein said third means includes means for comparing the text representing said first image to said text representing said second image (OCR software for comparing texts are well known and widely available).

Claims 6-9 & 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moscato and Pierce as described in claims 1-5, and 21 above, and in view of Schwenk et al (6590995).

Regarding claims 6 & 22, combinations of Moscato and Pierce do not expressly disclose a verification system includes means for adding a fingerprint to an image.

Schwenk, in the same field of endeavor for securing documents, teaches a verifying includes means for adding a fingerprint to a digital image (adding a digital fingerprint into a digital document, abstract, col.1, lines 20-25 and col. 2, lines 3-22). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify print system of Moscato and Piece to include a means for adding a fingerprint to an image as per teachings of Schwenk because of a following reason: (●) to add more security to the confidential documents by incorporating fingerprints onto the documents as being processed by Moscato.

Therefore, it would have been obvious to combine Moscato and Pierce with Schwenk to obtain the invention as specified in claims 6 & 22.

Regarding claims 7 & 23, Moscato further teaches means for printing (printer 15, fig. 2) said fingerprint on said document (printing fingerprint on document is well known in the art).

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Regarding claims 8 & 24, Moscato further teaches a scanner (scanner 20, 23, fig. 2) is adapted to scan said fingerprint and provide a fingerprint output signal in response thereto (scanning fingerprint is well known in the art).

Regarding claims 9 & 25, combinations of Moscato, Pierce and Schwenk teach disabling said printer when said fingerprint of said printed version is not detected in an image that is purported to be a scanned copy of said printed version (incorporating a fingerprint into a document prevents hackers/unauthorized users from duplicating unauthorized copies of confidential/protected documents as taught by Schwenk, abstract, and col. 2, lines 3-67).

Response to Arguments

Applicant's arguments with respect to claims 1 & 21 have been considered but are moot in view of the new ground(s) of rejection due to newly added features/limitations "***from another print request***".

- Regarding claim 35, the applicants argued the cited prior arts of record fail to teach and/or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed version from being produced ***from another print request*** if said output is signified to be a successful print".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ***from another print request***) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

However, the cited prior art of record (US 6088119 to Manchala et al) clearly teaches a prohibition of additional printed version from being produced if said output is signified to be a successful print (reprinting is prohibited if the first printed check is successful printed, col. 2, lines 30 to col. 3, lines 35 and col. 5, lines 1-10). In additional, Kitabatake

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(US 6099181) clearly teaches a prohibition of printing another copy if a first printed copy is successfully printed (reprinting is prohibited if the printed page has been successfully printed, col. 2, lines 8-11, col. 11, lines 18-45).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 5319562 to Whitehouse, which teaches a well-known example of wherein multiple copies of postage or duplication of already printed postage is prevented from printing.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

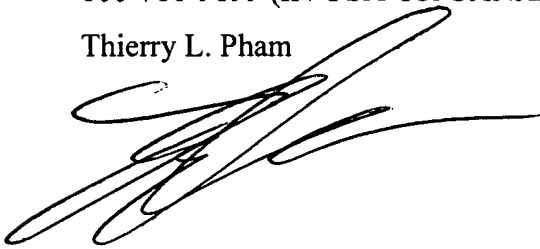
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thierry L. Pham

GABRIEL GARCIA
PRIMARY EXAMINER